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10/748,196	12/31/2003	Donald M. Berlin	1751.1001	6739

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EXAMINER	
LE, MIRANDA	
ART UNIT	**PAPER NUMBER**
2167	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/748,196	BERLIN ET AL.	
	Examiner	Art Unit	
	Miranda Le	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 June 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/22/07 has been entered.

2. This communication is responsive to Amendment filed 06/22/07

This action is made non-final.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Breed et al. (US Patent No. 6,944,628, in view of Penzias et al. (US Patent No. 5,577,120).

As per claim 10, De Breed teaches a computer-implemented method of identifying a person, comprising:

given non-uniquely identified target names and target ages/addresses corresponding to target persons *(i.e. name, telephone numbers, fax number and/or postal codes, col. 1, lines 25-30)*, and using a comprehensive public record dataset produced by combining multiple disparate public record databases of data of a general population including the target persons *(i.e. the addresses from the database are linked to publicly accessible data, col. 1, lines 43-35)*, automatically determining with substantial certainly that a target name corresponds with a particular unique individual in the general population, thereby identifying the person corresponding to the target name and delivering that determination *(i.e. the method for processing and/or sending one or more e-mail messages in electronic manner, wherein the addresses of people and/or organizations are stored in a database, and wherein the addresses from the database are linked to publicly accessible data such as name, telephone numbers, fax number and/or postal codes, col. 1, lines 31-38).*

De Breed does not teach:

without a key or identifier uniquely identifying the target person.

Penzias teaches without a key or identifier uniquely identifying the target person *(i.e. physical verification information, col. 2, lines 35-54).*

It would have been obvious to one of ordinary skill of the art having the teaching of Ref1 and Penzias at the time the invention was made to modify the system of Ref1 to include the limitations as taught by Penzias.

One of ordinary skill in the art would be motivated to make this combination in order to have a greater measure of security against fraud in view of Penzias, as doing so would give the added benefit of retrospectively identifying an individual who had engaged in a commercial,

retail or other transaction so that that individual can be later found in the future as taught by Penzias (col. 1, line 7-12).

As per claim 11, De Breed teaches a method according to claim 10, wherein the determining is based only on the target name and target age/address *(i.e. name, telephone numbers, fax number and/or postal codes, col. 1, lines 25-30).*

As per claim 12, De Breed teaches a method according to claim 10, wherein the determining is done without a key or identifier uniquely identifying the target person among the general population and by using the public record dataset to link the target person to the particular individual in the general population *(i.e. A preferred embodiment of the method for processing and/or sending one or more e-mail messages in electronic manner, wherein the addresses of people and/or organizations are stored in a database, and wherein the addresses from the database are linked to publicly accessible data such as name, telephone numbers, fax number and/or postal codes, col. 1, lines 31-38).*

As per claim 13, De Breed teaches a method according to claim 12, wherein the key or identifier comprises a social security number or an identifier that serves as a proxy therefore *(i.e. If using an internet site a data set is available or made accessible in which all publicly known data of private individuals and/or organisations is stored, anyone who so wishes can link his e-mail address thereto in a manner which is visible or invisible to the sender of a message, col. 1, lines 43-55).*

5. Claims 1-9, 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Breed et al. (US Patent No. 6,944,628, in view of Penzias et al. (US Patent No. 5,577,120), and further in view of Tanner et al. (US Pub No. 20040243588).

As to claims 1, 17, De Breed teaches a method of delivering a non-uniquely identified name that substantially corresponds to a uniquely identified person, the method comprising:

accessing a source dataset *(i.e. database, col. 1, lines 25-30)* of uniquely identified persons *(i.e. addresses of people and/or organizations are stored in a database, col. 1, lines 25-30)*, the dataset comprising records comprising, for each uniquely identified person, a source name, a source unique identifier, a source date of birth, and a source address;

accessing a target dataset *(i.e. publicly accessible data, col. 1, lines 25-30)*, not derived from the source dataset, of non-uniquely identified persons, the dataset comprising records comprising, for each non-uniquely identified person, a target name *(i.e. name, telephone numbers, fax number and/or postal codes, col. 1, lines 25-30)*;

for a particular source person in the source dataset, and in accordance with the accessing the target dataset, automatically whether the particular source person corresponds to a particular target person in the target dataset *(i.e. the addresses from the database are linked to publicly accessible data, col. 1, lines 43-35)* and delivering the determination *(i.e. the method for processing and/or sending one or more e-mail messages in electronic manner, wherein the addresses of people and/or organizations are stored in a database, and wherein the addresses from the database are linked to publicly accessible data such as name, telephone numbers, fax number and/or postal codes, col. 1, lines 31-38).*

De Breed does not explicitly teach: a private source dataset, not derived from public data sources, of uniquely identified persons, identified by a global unique identifier and remains the same throughout the lifetime of the person; a target age, and a target age-date indicating an exact or approximate date age.

Penzias teaches a private source dataset *(i.e. a transaction card; The identity information is information that would be useful for actually finding the individual in the future, such as the individual's name and address, or at least a "pointer," such as a social security number, that can be used to access a file stored elsewhere containing the name, address, complete physical description, digitized photograph, fingerprints, etc., of the individual, col. 4, lines 25-67),* not derived from public data sources *(i.e. Federal Bureau of Investigation (FBI), col. 4, lines 25-67)*, of uniquely identified persons, identified by a global unique identifier and remains the same throughout the lifetime of the person *(i.e. However, if a greater measure of security against fraud is desired, the processing performed by branch office 110 could include such further measures as obtaining a full set of fingerprints from the individual and obtaining the person's identity from the Federal Bureau of Investigation (FBI), at least for those individuals whose prints are on file, col. 4, lines 25-67).*

It would have been obvious to one of ordinary skill of the art having the teaching of De Breed and Penzias at the time the invention was made to modify the system of Ref1 to include the limitations as taught by Penzias.

One of ordinary skill in the art would be motivated to make this combination in order to have a greater measure of security against fraud in view of Penzias, as doing so would give the added benefit of retrospectively identifying an individual who had engaged in a commercial,

retail or other transaction so that that individual can be later found in the future as taught by Penzias (col. 1, line 7-12).

De Breed and Penzias do not teach a target age, and a target age-date indicating an exact or approximate date age.

Tanner teaches a target age, and a target age-date indicating an exact or approximate date age *(i.e. a date of birth, or an age of the person; or unique personal information such as the name of a spouse or maiden name; or any other personal identification information or business identification information, [0055]).*

It would have been obvious to one of ordinary skill of the art having the teaching of De Breed, Penzias and Tanner at the time the invention was made to modify the system of De Breed, Penzias to include the limitations as taught by Tanner.

One of ordinary skill in the art would be motivated to make this combination in order to administer customer inquiry requests for information in view of Tanner, as doing so would give the added benefit of having a third-party initiated a new account with a customer, a *name* or other information associated with the third-party which can be part of an inquiry request that is automatically transmitted by the customer or a system associated with the customer, as taught by Tanner *([0055]).*

As per claim 2, Tanner teaches a method according to claim 1, wherein the automatically determining comprises matching a target identifier in the target dataset with an identifier of the particular source person when the identifier of the particular source person is available, whereby the uniquely identified particular person is determined to correspond to the particular target

person *(i.e. filtering potential matching records and removing at least some false positives; determining positive matching records in the global information database to the inquiry requests, [0026]).*

As per claim 3, Tanner teaches a method according to claim 2, wherein the automatically determining further comprises matching the date of birth and name of the particular source person with the particular target person based on the name, the target age, and the target age-date of the particular target person, whereby the uniquely identified particular person is determined to correspond to the particular target person *(i.e. An inquiry request can include, but is not limited to, a person's name, a business or company name, an entity name, in combination with location information such as city, state, or zip code; or unique numerical identification information such as a social security number, a federal tax ID number, an account number, a date of birth, or an age of the person; or unique personal information such as the name of a spouse or maiden name; or any other personal identification information or business identification information, [0055]).*

As per claim 4, Tanner teaches a method according to claim 3, wherein the automatically determining further comprises matching the address of the particular source person with the address of the particular target person, whereby the uniquely identified particular person is determined to correspond to the particular target person *(i.e. An inquiry request can include, but is not limited to, a person's name, a business or company name, an entity name, in combination with location information such as city, state, or zip code; or unique numerical identification*

information such as a social security number, a federal tax ID number, an account number, a date of birth, or an age of the person; or unique personal information such as the name of a spouse or maiden name; or any other personal identification information or business identification information, [0055]).

As per claim 5, Tanner teaches a method according to claim 4, wherein the automatically matching of addresses further comprises determining that the particular source person and the particular target person both have an address common to a set of current/previous addresses of the particular source person, where the set of current/previous addresses are obtained separately from and keyed to the source dataset *(i.e. first name, last name, age, address, date of birth, date of information, employment, position, and other associated information, [0318]).*

As per claim 6, Tanner teaches a method according to claim 5, wherein the automatically determining further comprises determining a uniqueness of the source name of the particular source person, and based on the uniqueness, determining whether the source name corresponds to the target name of the particular target person *(i.e. The Person/Company name filter can identify at least four types of records: a Person Name, Person Record (PNPR), in which the record has a person's name and is a person's record; Person Name, Business Record (PNBR), in which the record has a person's name but is a business record; Business Name, Business Record (BNBR), in which the record has a business name and is a business record; and Business Name, Person Record (BNPR), in which the record has a business name but is a person's record, [0180]).*

As per claim 7, Tanner teaches a method according to claim 6, further comprising automatically finding one or more persons who have co-resided with the particular source person using another dataset *(i.e. The Person/Company name filter can identify at least four types of records: a Person Name, Person Record (PNPR), in which the record has a person's name and is a person's record; Person Name, Business Record (PNBR), in which the record has a person's name but is a business record; Business Name, Business Record (BNBR), in which the record has a business name and is a business record; and Business Name, Person Record (BNPR), in which the record has a business name but is a person's record, [0180]).*

As per claim 8, Tanner teaches a method according to claim 7, wherein the automatically finding of one or more persons who have co-resided with the particular person is based on whether the one or more persons have lived at the particular person's source address for a predetermined period of time *(i.e. new daily grey file, [0097]),* and is based on whether the one or more persons have lived at two consecutive current/previous addresses in the set of current/previous addresses of the particular source person *(i.e. any other entity that desires to track information related to a particular person, name, [0056]).*

As per claim 9, Tanner teaches a method according to any of claims 1 through 8, wherein the target dataset comprises a set of officers or directors of publicly traded companies, wherein the source dataset comprises a set of potential market participants, and wherein the determining of a correspondence between the particular source person and the particular target person indicates a substantial likelihood that the particular source person is a market participant

that is also an officer or director of a publicly traded company *(i.e. Fair Credit Reporting Act (FCRA) and non-FCRA related data, published data, customer-supplied data, public information, and private information, [0099]).*

As per claim 14, De Breed, Penzias do not teach a method according to claim 10, wherein the determining is based on at least one of a date of birth of the particular individual, a degree of uniqueness of the target name, and a set of previous/former addresses of the particular individual.

However, Tanner teaches a method according to claim 10, wherein the determining is based on at least one of a date of birth of the particular individual, a degree of uniqueness of the target name, and a set of previous/former addresses of the particular individual *(i.e. generate a ranking or sequential order for the reduced or qualified list of potential matches depending upon the quality, quantitative value, or confidence level of the potential match, [0131]).*

It would have been obvious to one of ordinary skill of the art having the teaching of De Breed, Penzias and Tanner at the time the invention was made to modify the system of De Breed, Penzias to include the limitations as taught by Tanner.

One of ordinary skill in the art would be motivated to make this combination in order to administer customer inquiry requests for information in view of Tanner, as doing so would give the added benefit of when a third-party initiates a new account with a customer, a *name* or other information associated with the third-party can be part of an inquiry request that is automatically transmitted by the customer or a system associated with the customer as taught by Tanner *([0055]).*

As per claim 15, De Breed, Penzias does not teach a method according to any of claims 10 through 14, wherein the target persons comprise officers or directors of publicly traded companies.

However, Tanner teaches a method according to any of claims 10 through 14, wherein the target persons comprise officers or directors of publicly traded companies *(i.e. Fair Credit Reporting Act (FCRA) and non-FCRA related data, published data, customer-supplied data, public information, and private information, [0099]).*

It would have been obvious to one of ordinary skill of the art having the teaching of De Breed, Penzias and Tanner at the time the invention was made to modify the system of De Breed, Penzias to include the limitations as taught by Tanner.

One of ordinary skill in the art would be motivated to make this combination in order to administer customer inquiry requests for information in view of Tanner, as doing so would give the added benefit of when a third-party initiates a new account with a customer, a *name* or other information associated with the third-party can be part of an inquiry request that is automatically transmitted by the customer or a system associated with the customer as taught by Tanner *([0055]).*

As per claim 16, Tanner teaches a method according to claim 15, wherein the determining of a correspondence between the particular unique individual in the general population with the target name indicates a substantial likelihood that the particular unique individual is an officer or director of a publicly traded company *(i.e. generate a ranking or*

sequential order for the reduced or qualified list of potential matches depending upon the quality, quantitative value, or confidence level of the potential match, [0131]).

Response to Arguments

6. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham, can be reached on (571) 272-7079. The fax number to this Art Unit is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Miranda Le
August 30, 2007